UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CHARLES ABRAHAM

Appeal No. 2005-0347
Application No. 09/993,335

ON BRIEF

Before LEVY, SAADAT, and MACDONALD, ***Administrative Patent Judges***.

MACDONALD, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 2-3, 6-7, 26-27, and 30-31. Claims 4-5, 8-9, 28-29, and 32-33 are objected to as being dependent upon a rejected base claim. Claim 39 has been canceled. Claims 1, 10-25, 34-38, and 40-41 are withdrawn from consideration as not directed to the elected invention. See the Examiner's answer at page 2.

Invention

Appellant's invention relates to an apparatus and method for obtaining benefits associated with an Assisted Global Positioning Satellite device without requiring complete integration of a GPS device with a cellular handset.

Furthermore, the present invention facilitates a GPS handheld or mobile device configured to operate without subscription to a cell phone service provider, and thus eliminates fees for such subscription. An aspect of the present invention is a GPS handheld device that comprises a cellular acquisition signal receiver or front end. It will be appreciated that circuitry required to receive an acquisition signal comprises only a portion of a complete cellular handset. Particularly, a transmitter portion for communicating with a basestation of a cellular network is not included in the GPS handheld device. Furthermore, a digital signal processor and application processor(s) configured for modulating, demodulating, voice processing, call protocols, subscriber identification and the like are absent in the GPS handheld device. The cellular acquisition signal receiver allows the GPS handheld device to have an accurate time of day and/or frequency reference, thus assisting in GPS signal acquisition and GPS computation. Appellant's specification at page 2, the last three lines, through page 3, line 14.

Claim 2 is representative of the claimed invention and is reproduced as follows:

2. A method comprising:

obtaining a time synchronization signal from a cellular network at a global positioning system (GPS) handheld device without a subscription to the cellular network using a front end only capable of receiving signals from said cellular network;

determining a timing offset responsive to the time synchronization-signal;

determining a time of day responsive to the timing offset without having to have a subscription to the cellular network; and

processing satellite trajectory data within the GPS handheld device using the time of day.

References

The references relied on by the Examiner are as follows:

Krasner	6,150,980	Nov. 21, 2000
Kurby et al. (Kurby)	6,323,804	Nov. 27, 2001
		(Filed Jun. 6, 2000)

Rejections At Issue

Claims 2-3, 6-7, 26-27, and 30-31 stand rejected under 35 U.S.C. § 102 as being anticipated by Kurby.

Claims 2-3, 6, 26-27, and 30 stand rejected under 35 U.S.C. § 102 as being anticipated by Krasner.[1]

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.[2]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated ***infra***, we reverse the Examiner's rejection of claims 2-3, 6-7, 26-27, and 30-31 under 35 U.S.C. § 102.

Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant could have made but chose not to

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[1] Examiner's Answer incorrectly includes claims 7 and 31 in the statement of the rejection heading on page 5 of the answer.

make in the brief have not been considered. We deem such arguments to be waived by Appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)].

Appellant has indicated that for purposes of this appeal, the claims stand or fall together in two groupings corresponding to the two rejections listed above. See page 4 of the brief. Furthermore, Appellant argues each group of claims separately and explains why the claims of each group are believed to be separately patentable. See pages 6-13 of the brief and pages 2-3 of the reply brief. Appellant has fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellant's filing of the brief. 37 CFR § 1.192 (c)(7) states:

> *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

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[2] Appellant filed an appeal brief on April 19, 2004. Appellant filed a reply brief on September 1, 2004. The Examiner mailed an Examiner's Answer on June 29, 2004.

We will, thereby, consider Appellant's claims as standing or falling together in the two groups noted above, and we will treat:

Claim 2 as a representative claim of Group I (the Kurby rejection); and

Claim 2 as a representative claim of Group II (the Krasner rejection).

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. ***In re McDaniel***, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). ***See also In re Watts***, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. ***Whether the Rejection of Claims 2-3, 6-7, 26-27, and 30-31 Under 35 U.S.C. § 102 is proper?***

It is our view, after consideration of the record before us, that the disclosure of Kurby does not fully meet the invention as recited in claims 2-3, 6-7, 26-27, and 30-31. Accordingly, we reverse.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 2, at page 7 of the brief, Appellant cites to Kurby at column 5, lines 33-37, and argues "Kurby fails to teach or suggest using the absolute device time transmitted by the satellites to process

satellite trajectory data." We find this argument unpersuasive. We agree that column 5, lines 33-37, of Kurby do not teach the claimed processing of satellite trajectory data. However, lines 38-41 of column 5 refer to determining location by the "techniques used in the GPS system" and column 3, lines 52-54, teaches that the GPS system location determining techniques process time data "to triangulate the position thereof." Thus, we find that Kurby teaches processing satellite trajectory data.

Appellant also argues at page 2 of the reply brief that there is no teaching in Kurby of "using a time synchronization signal from a cellular network." This argument goes unchallenged by the Examiner. We have reviewed the Kurby patent and we find Appellant's argument persuasive. We find no time synchronization signal from a cellular network. Rather, Kurby's time synchronization signal comes from the satellite 208 as part of data signal 210.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 2-3, 6, 26-27, and 30 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Krasner does not fully meet the invention as recited in claims 2-3, 6, 26-27, and 30. Accordingly, we reverse.

With respect to independent claim 2, Appellant argues at pages 11-13 of the brief that Krasner fails to teach "using a front end only capable of receiving

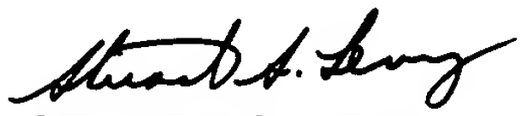
signals" as recited in claim 2. The Examiner responds in the answer at page 6, "there is nothing in the method of operation of Krasner . . . that requires or uses the transmitting portion of the cellular telephone."

We find the Examiner's position unpersuasive. While it might be argued that it is obvious in the extreme to remove the transmitting portion of Krasner's cellular telephone and its corresponding functions, we find that doing so is not taught in Krasner as required by 35 U.S.C. § 102. We find that the Examiner has not met his initial burden of establishing a ***prima facie*** case of anticipation, and we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 102 of claims 2-3, 6-7, 26-27, and 30-31.

REVERSED



STUART S. LEVY)
Administrative Patent Judge)
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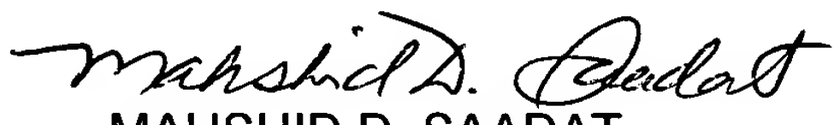
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MAHSHID D. SAADAT) APPEALS AND
Administrative Patent Judge) INTERFERENCES

)
ALLEN R. MACDONALD)
Administrative Patent Judge)

ARM/lbg

MOSER, PATTERSON & SHERIDAN L.L.P.
595 SHREWSBURY AVE, STE 100
FIRST FLOOR
SHREWSBURY, NJ 07702